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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,454	12/16/2003	K. Dane Wittrup	97-99E	8855
23713 7590 02/28/2007 GREENLEE WINNER AND SULLIVAN P C 4875 PEARL EAST CIRCLE SUITE 200 BOULDER, CO 80301			EXAMINER GUZO, DAVID	
			ART UNIT 1636	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/28/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/738,454

Applicant(s)

WITTRUP ET AL.

Examiner

David Guzo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-97 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 30-97 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-29 is/are allowed.
- 6) ☒ Claim(s) 10, 11, 15, 16, 22, 23 and 25 is/are rejected.
- 7) ☒ Claim(s) 12-14, 17-21 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/16/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Claims 1-9 and 30-97 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/20/05.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 10-11, 15-16, 22-23 and 25 are rejected under 35 U.S.C. 102(a) as being anticipated by Boder et al.

The Declaration under 37 CFR 1.132 filed 11/17/06 is insufficient to overcome the rejection of claims 10-11, 15-16, 22-23 and 25 based upon 35 USC 102(a) as set forth in the last Office action because: The declaration does not adequately set forth that the inventorship of the application is correct in light of the cited reference. The Declaration filed 11/17/06 does not indicate that the relevant portions of the reference originated with or were obtained from applicants. Declarants indicate that the reference (Boder et al. abstract) was "...prepared by co-inventors Boder and Wittrup for a poster presentation made by Boder and Wittrup" and that "...all named inventors made original intellectual contributions to the conception of the invention..." as claimed in the claims rejected over the Boder et al. reference.

Initially, it is noted that declarants did not indicate what portions of the Boder et al. abstract originated with applicants. The declaration indicates that the Boder et al. abstract "was prepared by" inventors Boder and Wittrup for a poster presentation by said inventors. It is unclear what "prepared by" means, i.e. does this mean that all of the subject matter disclosed in the Boder et al. reference was invented exclusively by Boder and Wittrup? The declaration does not unequivocally indicate what subject matter was invented by Boder and Wittrup. Furthermore, if one assumes that declarants mean to state that Boder and Wittrup alone invented the subject matter disclosed in the Boder et al. reference, then declarants' other statement that "...all named inventors made original intellectual contributions to the conception of the invention..." as claimed in the claims rejected over the Boder et al. reference appears contradictory to the previous statement. Declarants appear to be indicating that Boder and Wittrup invented the claimed subject matter under rejection over the Boder et al. reference **and** that all of the named inventors made original intellectual contributions to the conception of (i.e. invented) the same claims.

Declarants' other statements "That all persons named as co-inventors of the above-referenced application made original intellectual contributions to the conception of at least one claim pending in the above-referenced application" and "That the inventorship of the claims pending in the above-referenced application is correct" do not cure the defects of the prior statements in the declaration. The statement that all persons named as co-inventors in the instant application made original contributions to the conception "of at least one claim" in the application is unclear because the pending

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claims include withdrawn claims as well as claims currently under examination which includes a subset of claims rejected over the Boder et al. reference. It is unclear what "at least one claim" declarants are referring to. The statement that the inventorship of the pending claims in the instant application is correct also does not address the relevant issues with regard to the disclosure of the Boder et al. reference and the discrepancy in the authorship of the reference and the inventorship of the instant claims.

Any rejections not repeated in this Office Action are withdrawn.

Claims 27-29 are allowed.

Claims 12-14, 17-21 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo, Ph.D., whose telephone number is (571) 272-0767. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, Ph.D., can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Guzo
February 7, 2007


DAVID GUZO
PRIMARY EXAMINER